



Docket No.: 2328-053

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of

NI, TUQUIANG

U.S. Patent Application No. 09/821,753

Filed: March 30, 2001

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Group Art Unit: 1763

Examiner: ALEJANDRO MULERO,  
LUZ L.

For: PLASMA PROCESSING METHOD AND APPARATUS WITH CONTROL OF  
PLASMA EXCITATION POWER

Commissioner For Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**REQUEST FOR WAIVER/REFUND OF EXTENSION OF TIME FEES**

Applicant, through their undersigned attorney, respectfully requests waiver/refund of the  
extension fees set forth in 37 CFR 1.17 based on the following:

1. A Final Rejection was mailed to applicant on August 19, 2003;
2. A response to the Final Rejection was effectively filed by applicant within two  
month period on October 20, 2003 (copy of cover page affixed with certificate of  
mailing is appended hereto);
3. An Advisory Action was issued by Examiner Alejandro-Mulero on November 3,  
2003;
4. Said Advisory Action identified claims 14-16 as being withdrawn from  
consideration;
5. Applicant responded to said Advisory Action on November 6, 2003 – the letter  
provided reasons why the Advisory Action incorrectly refused entry of the  
Amendment After Final Rejection;
6. A second Advisory Action, was mailed to Applicant on February 11, 2004. The  
second Advisory Action, failed to respond to the reasons set forth in the November 6,

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2003 as to why the Advisory Action improperly refused entry of the Amendment. The presumption, therefore, is the original Advisory Action incorrectly refused entry of the Amendment After Final Rejection. The February 11, 2004 Advisory Action gave new, previously never mentioned rationale as to why the Amendment After Final Rejection would not place the application into condition for allowance. By saying the October 20, 2003 Amendment to claim 14 was such that claim 14 was no longer withdrawn from consideration. This statement is made in the written portion of the Advisory Action, but is contrary to the box checked on page 1 of the Advisory Action, which indicates claim 14 remains withdrawn from prosecution. The February 11, 2004 Advisory Action also stated that the Examiner did not have adequate time to consider the Declaration submitted with the Advisory Action because the Declaration was untimely filed. This statement was made despite the fact that the Declaration was effectively submitted within two months of the Final Rejection. In addition, the vast majority of the Declaration dealt with issues that had been raised for the first time in the Response to the Final Rejection; viz: issues under 35 USC 112, ¶1. Obviously, applicants could not have submitted a Declaration in response to the newly raised issues in the Final Rejection before the Examiner raised these issues.

### **ARGUMENT**

Page 9 of the Office Action indicates that if a response to a Final Rejection is submitted within two months of the Final Rejection and the advisory action is not mailed until after the end of the THREE month shortened statutory period, the shortened statutory period will expire “on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action”, and therefore the applicant is not required to pay extension fees. Applicant satisfied this requirement. The November 3, 2003 Advisory Action was incorrectly issued, as evidenced by the Examiner’s acquiescence to the rationale set

forth in the November 6, 2003 letter. While there was no direct acquiescence, the Examiner's silence, in the February 11, 2004 Advisory Action, amounts to an acquiescence.

Hence, the effective date of the Advisory Action is February 11, 2004. As a result, there should be no extension fees. If the Examiner had raised the issues set forth in the February 11, 2004 earlier, Applicants would have had the opportunity to take appropriate action, such as filing an RCE. Instead, the effective date of the Advisory Action was approximately one week prior to the expiration of the six month period. Consequently, Applicants are not at fault for the delay associated with the extension.

Based on the foregoing, a refund of the extension fee is in order.

Respectfully submitted,

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**February 19, 2004**